

REMARKS

Claims 51 to 58 are added, and therefore claims 22 to 43, 45, 46, and 49 to 58 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to paragraph three (3) on page two (2) of the Office Action, claims 22, 24, and 34 were objected to for informalities. Although the objections may not be agreed with, to facilitate the matter, claims 22, 24, and 34 have been rewritten. Withdrawal of the objections as to claims 22, 24, and 34 is therefore respectfully requested.

As to paragraph five (5) on page two (2) of the Office Action, claims 22 to 24, 26 to 28, 31 to 34, 36, 38 to 43, 45, and 50 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,334,824 (Martinez), in view of U.S. Patent No. 5,887,269 (Bruns), and in further view of U.S. Patent Pub. No. 2003/0154075 (Schalk).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there may be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination may be found in the prior art and not based on the application disclosure. *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580

(C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claim 22 has been rewritten to better clarify the claimed subject matter.

Claim 22, as presented, relates to a *method for transmitting data between a motor vehicle controller having a first processor and a test unit having a second processor*, and includes, as amended herein without prejudice, *the features of transmitting first data to the motor vehicle controller to be used at the first processor, determining second data as a function of the first data, transmitting the second data to the second processor, checking the second data in the second processor to determine if the first data may be used in the first processor, transmitting a check result to the first processor, the check result being a positive or a negative check result, responsive to receiving a positive check result, using the first data at the first processor, and making repeated usage inquiries to the second processor each after a preselected time interval.*

The Martinez reference merely relates to a mobile device for credit card transaction at a consumer's home. The cited portions of Martinez may be chiefly summarized as follows. A consumer at home may submit a credit card (with a credit card number) to the mobile device which may encrypt the credit card number and transmit the encrypted information to a host computer. The host computer may validate the credit card information and transmit an approval to the mobile device to complete a transaction. After the completion of the transaction, the mobile device may print a receipt. The Office Action apparently asserts that the credit card number and its encrypted version respectively correspond to the first data and the second data provided for in the context of claim 22. Further, the Office Action contends that "printing the receipt" corresponds to using (or processing) the first data at the first processor.

The asserted interpretation of Martinez, however, does not disclose (or suggest) all features as provided for in the context of claim 22, as presented. If the credit card number, as apparently asserted, corresponded to the first data, the use of the credit card number would have been finished after the host computer validate it and transmit an approval to the mobile device for further completing a transaction. As such, the cited portions of Martinez does not disclose the feature of being *responsive to receiving a positive check result, using the first data at the first processor*, as provided for in the context of claim 22, as presented.

The Office Action conclusorily asserts that “printing a receipt” somehow corresponds to *using the first data at the first processor*. However, “printing a receipt” simply does not depend on the credit card number after the transaction has been completed. It cannot be reasonably asserted that the first processor uses the credit card number to print a receipt. Furthermore, claim 22, as presented, provides for *making repeated usage inquiries at the second processor each after a preselected time interval*. The cited portions (or any reading for that matter) of Martinez makes plain that it does not disclose (or even suggest) this feature. Moreover, any reading of Brunts or Schalk makes plain that these references, whether taken alone or combined, also do not disclose this feature.

Accordingly, claim 22, as presented, is allowable, as are its dependent claims.

Claims 24, 34, and 41 to 43, as presented, include features similar to those of claim 22, as presented, and are therefore allowable for essentially the same reasons as claim 22.

Claims 23, 25 to 33, 35 to 40, 45, and 50, as presented, depend from claims 22, 24, 34, or 41 to 44, and are therefore allowable for the same reasons.

It is therefore respectfully requested that the obviousness rejections of claims 22 to 24, 26 to 28, 31 to 34, 36, 38 to 43, 45, and 50 be withdrawn.

With respect to page five (5) of the Office Action, claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Martinez, Brunts, and Schalk, and in further view of U.S. Patent No. 6,704,872 (Okada).

It is respectfully submitted that even if it were proper to modify the combination of Martinez, Brunts, and Schalk, as asserted by the Office Action (which is not conceded), Okada does not cure the critical deficiencies of the combination of Martinez, Brunts, and Schalk (as explained above) with respect to claim 22 as presented, from which claim 25 depends. Accordingly, claim 25 is allowable for at least the same reasons as claim 22, as presented, since Okada does not cure the critical deficiencies of the combination of the Martinez, Brunts, and Schalk references.

With respect to page five (5) of the Office Action, claim 35 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Martinez, Brunts, and Schalk, and in further view of U.S. Patent No. 4,264,960 (Gurr).

It is respectfully submitted that Gurr does not cure the critical deficiencies of the combination of Martinez, Brunts, and Schalk (as explained above) with respect to claim 22 as presented, from which claim 35 depends. Accordingly, claim 35 is allowable for at least the same reasons as claim 22, as presented.

With respect to page six (6) of the Office Action, claims 37 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Martinez, Brunts, and Schalk, and in further view of U.S. Patent No. 5,790,664 (Coley).

It is respectfully submitted that the Coley reference does not cure the critical deficiencies of the combination of Martinez, Brunts, and Schalk (as explained above) with respect to claim 22 as presented, from which claims 37 and 46 depend. Accordingly, claims 37 and 46 are allowable for at least the same reasons as claim 22, as presented.

With respect to page seven (7) of the Office Action, claim 49 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Martinez, Brunts, and Schalk, and in further view of U.S. Patent No. 7,233,948 (Shamoon).

Claim 49 includes features essentially the same as claim 22 and therefore is allowable for essentially the same reasons as claim 22 since the Shamoon reference does not cure (or allegedly cure) the critical deficiencies of the combination of Martinez, Brunts, and Schalk as to claim 22.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by that Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Withdrawal of the obviousness rejections is therefore respectfully requested.

New claims 51 to 58 do not add any new matter and are wholly supported by the present application as originally filed. Further, new claims 51 to 58 depend from claim 22, as presented, and are therefore allowable for the same reasons as claim 22, as presented.

New claim 58 includes features like claim 51, and is therefore allowable for essentially the same reasons. Also, this claim corresponds to claim 1 of the corresponding European application, which has been accepted during the opposition procedure.

Accordingly, all of pending claims 22 to 43, 45, 46, 49 to 58 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Office have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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